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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/676,319

09/29/2000

Ernie F. Brickell

10559/329001/P9832

1992

20985

7590

06/28/2004

FISH & RICHARDSON, PC
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EXAMINER

HENNING, MATTHEW T

ART UNIT

PAPER NUMBER

2131

6

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,319

Applicant(s)

BRICKELL ET AL.

Examiner

Matthew T Henning

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This action is in response to the communication filed on 09/29/2000.

DETAILED ACTION

1. Claims 1-41 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 09/29/2000.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 01/12/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

6. The drawings filed on 09/29/2000 are acceptable for examination proceedings.

Specification

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The abstract of the disclosure is objected to because

Line 1: "MANAGED AUTHENTICATION SERVICE" must be removed, as it is not a proper heading for the Abstract of the Disclosure.

Line 4: The phrase "is described" can be implied and therefore must be removed.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

9. Claims 4, and 38 - 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation " for the digital certificate " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 38 Lines 6 and 7, and Claim 40 Line 2 recite the limitation "substantially" and are therefore rejected. This is because one of ordinary skill in the art could not

Art Unit: 2131

determine how static information needed to be in order to be considered “substantially static”, or how dynamic information needed to be in order to be considered “substantially dynamic”, or how often is comprised by “a substantially regular basis” and therefore would not be able to determine the scope of these claims.

Claims 39 and 41 are rejected by virtue of their dependency on claim 38.

See MPEP § 608.01(i).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claim 1-5, 13-17, 25-27, and 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by French et al. (U.S. Patent Number 6,321,339) hereinafter referred to as French.

12. Claim 1 recites receiving registration information from a user (See French Fig. 1 Elements 16, 18, and 20), verifying registration information (See French Fig. 1 Elements 32 and 40), issuing digital credential to user based on result from verification (See French Fig. 3 Elements 314 and 318), and communicating the registration information to a central authentication service (See French Col. 5 Paragraph 8 – Col. 6 Paragraph 2).

13. Claim 2 recites communicating registration status of the user to the authentication service. French disclosed logging a transaction record of data sent to and from the authorization database (See French Col. 5 Paragraph 6)

14. Claim 3 recites uploading client software to the user's computer in order to provide real-time authentication (See French Col. 6 Paragraph 7).

15. Claim 4 recites generating a confirmation level based on the verification of the registration information (See French Col. 2 Paragraph 3).

16. Claim 5 recites that verifying registration information includes verifying a medical license number, which the examiner is interpreting to mean any official personal identification information. French disclosed verifying a user's driver's license number and social security number (See French Fig. 11).

17. Claim 13 recites initiating a challenge response sequence from a client computer when a user uses a digital credential (See French Fig. 1 Element 12). Claim 13 further recites receiving a challenge from a remote server (See French Fig. 1 Element 14).

Claim 13 finally recites responding to the challenge using the digital credential (See French Fig. 1 Elements 16, 18, 20, and 22).

18. Claim 14 recites accessing a registration authority to receive the digital credential (See French Fig. 31).

19. Claim 15 recites forwarding the digital credential to a central authentication service in response to the challenge received from the remote server (See French Col. 5 Paragraph 8 – Col. 6 Paragraph 2).

20. Claim 16 recites a browser configured to access a remote server (See French Col. 5 paragraph 4), and a plug-in module executed by the browser to cause the server to perform a challenge response sequence when a user uses a digital credential.

French disclosed the use of Java applets in the authentication process to challenge for user information (See French Col. 6 Paragraph 7 and Fig. 31)

21. Claim 17 recites the plug-in being a java applet (See French Col. 6 Paragraph 7).

22. Claim 25 recites an authentication server (See French Fig. 12 Element 120) in communication with a database (See French Fig. 12 Element 152), in which the database stores user input from a registration authority (See French Fig. 12 Element 130) and the authentication server verifies the information in the database (See French Col. 5 Paragraph 6 and Col. 6 Paragraph 5).

23. Claim 26 recites the authentication server receiving a digital credential from a relying party (See French Col. 11 Paragraph 4).

24. Claim 27 recites verifying an identity of a user based on the digital credential, a registration status of the user, and authenticating the digital credential based on the verifications (See French Fig. 1 Elements 32, 34, and 38).

25. Claim 38 recites creating a digital credential based on information received from a registration authority where the information includes both static and dynamic information (See rejection of claim 1 and further French Col. 2. Paragraph 10 – Col. 3 Paragraph 1).

26. Claim 39 recites the static information including registration information and the dynamic information including good standing information. French disclosed the information including name and address (registration information) (See French Col. 2. Paragraph 10 – Col. 3 Paragraph 1) as well as credit report information (good standing information) (See French Col. 3 Paragraph 3).

27. Claim 40 recites updating the dynamic information. It was inherent that credit report information was updated regularly, as is required by credit reports.

28. Claim 41 recites recording biometric data (See French Col. 12 Paragraph 4).

29. Claims 6-8, 10-11, 18-19, and 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Menezes et al. ("Handbook of Applied Cryptography") hereinafter referred to as Menezes.

30. Claim 6 recites receiving a digital credential associated with a user registered with a registration authority. Menezes disclosed acquiring a public-key certificate corresponding to a subject A (See Menezes Page 560 Section ii Lines 5-7) wherein subject A was registered with a certificate authority (See Menezes Page 560 Section i).

Claim 6 further recites verifying the identity and registration status of the user, thereby authenticating the digital credential. Menezes disclosed the acquired certificate agreeing with the user identity (See Menezes Page 560 Section ii Line 7). Menezes further disclosed verifying the certificate's timestamp, signature, and that the certificate had not been revoked (See Menezes Page 560 Section ii/4/a-d). Menezes also disclosed that this process is used to authenticate the digital certificate (See Menezes Page 560 Section ii/5).

31. Claim 7 recites that verifying the registration status includes accessing a local copy of registration information maintained by the registration authority. Menezes disclosed acquiring the certificate from a central public database and then verifying the timestamp validity period in the certificate (See Menezes Page 560 Section ii/3-4).

32. Claim 8 recites that verifying registration status includes querying the registration authority. Menezes disclosed acquiring the public key of the certification authority in order to verify the information in the certificate (See Menezes Page 560 Section ii/1, 4b-c).

33. Claim 10 recites verifying the signature on the digital credential using a public key of the registration authority (See Menezes Page 560 Section ii/4/c).

34. Claim 11 recites reporting the result of the verification to the relying party. Menezes disclosed party B (the relying party) accepting the public key in the certificate as authentic depending on the verifying steps performed on the certificate (See Menezes Page 560 Section ii/5). It was inherent that the result of the verification was

reported to party B in order for the key to be either authenticated or not depending on the result of the verification.

35. Claim 18 rejected under 35 U.S.C. 102(b) as being anticipated by AberdeenGroup (Evaluating the Cost of Ownership for Digital Certificate Projects).

Claim 18 recites forming a contract with a relying party to centrally authenticate digital credentials issued by a registration authority, and charging the relying party.

AberdeenGroup disclosed VeriSign, a well-known Certificate Authority for authenticating digital certificates, charging for its services on a time basis (See AberdeenGroup Fig. 1).

This constitutes a subscription and therefore a contract is inherently formed.

36. Claim 19 recites charging on a subscription basis. Aberdeen disclosed that VeriSign charged on a timed basis (See AberdeenGroup Fig. 1). This constitutes a subscription.

37. Claims 28-32 are rejected for the same reasons as claims 6-10 above and further because it was inherent that computer program instructions were provided for the authentication of Menezes to function properly in a computer environment.

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

Art Unit: 2131

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes as applied to claim 6 above, and further in view of Aucsmith et al. (U.S. Patent Number 5,712,914) hereinafter referred to as Aucsmith.

Menezes disclosed a method of verifying digital certificates and verifying a registration status (See Menezes Page 560 Section ii), but Menezes failed to disclose that checking the registration status included checking the validity of a license of the user.

Aucsmith teaches that digital certificates can be used in order to validate a driver's license (See Aucsmith Col. 13 Paragraph 2). Aucsmith teaches that the certificate is first validated, at which point the driver's license in the certificate is validated (See Aucsmith Col. 13 Paragraph 2).

It would have been obvious to the ordinary person skilled in the art at the time invention to employ the teachings of Aucsmith to the digital certificates of Menezes in order to provide a method for authenticating a driver's license. This would have been obvious because one of ordinary skill in the art would have been motivated to provide a secure method of identification to a user.

40. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes as applied to claim 6 above, and further in view of Wobber et al. (U.S. Patent Number 5,235,642) hereinafter referred to as Wobber.

Menezes disclosed a method of verifying digital certificates and verifying a registration status (See Menezes Page 560 Section ii), but Menezes failed to disclose storing the result of the verification in an activity log.

Wobber teaches that the authentication process can be expedited if the result of the authentication is stored in a record along with the authentication credentials (See Wobber Col. 2 Paragraph 2).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Wobber to the authentication method of Menezes. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the user with the quickest authentication possible.

41. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over AberdeenGroup as applied to claim 18 above, and further in view of Magic, Inc. ("Meteor Security: Some Speculations"), hereinafter referred to as Magic.

AberdeenGroup disclosed charging a subscription fee for an authentication service utilizing digital certificates (See AberdeenGroup Fig. 1), but failed to disclose the possibility of charging on a use-by-use basis.

Magic teaches that if the number of financial and school partners is low, then it would be cost-effective to use ACES certificates for communication security (See Magic Page 3 Paragraph 3). Magic further teaches that ACES certificates charge a per use transaction fee (See Magic Paragraph 2 Line 1).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Magic to the method of AberdeenGroup in order to

charge for the use of digital certificates. This would have been obvious because one of ordinary skill in the art would have been motivated to provide a cost-effective way to provide the security of digital certificates to a user.

42. Claim 21 rejected under 35 U.S.C. 103(a) as being unpatentable over AberdeenGroup as applied to claim 18 above, and further in view of Menezes.

AberdeenGroup disclosed a subscription based authentication service utilizing digital certificates (See AberdeenGroup Fig. 1), but failed to disclose how to implement the digital certificates.

Menezes teaches a method for implementing digital certificates which includes verifying the identity of a user based on a digital credential and verifying a registration status of the user with a registration authority (See rejection of Claim 6 above).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Menezes to the method of AberdeenGroup in order to implement the digital certificates. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the security of digital certificates to its users.

43. Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over AberdeenGroup as applied to claim 18 above, and further in view of Matonis ("User-Friendly Digital Signatures"), hereinafter referred to as Matonis.

AberdeenGroup disclosed a subscription based authentication service utilizing digital certificates (See AberdeenGroup Fig. 1), but failed to disclose requiring the communications between users to be required in the contract.

Matonis teaches that in order to guarantee authentication of a sender, the use of digital signatures must be enforced (See Matonis Page 26).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Matonis to the method of AberdeenGroup in order to enforce the use of digital signatures by requiring it in the contract. This would have been obvious because the ordinary person skilled in the art would have been motivated to guarantee the authentication of a sender to a receiver.

44. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over French, and further in view of Herrmann (U.S. Patent Number 5,995,756) hereinafter referred to as Herrmann.

French disclosed a method for authenticating users in order to issue a digital certificate involving providing an input form to a user, receiving the completed form and forwarding the digital credentials from the completed form to an authentication server (See French Fig.1, 31-33, and 45, and Col. 14 Paragraph 4), but French failed to disclose that the input form was digitally signed before providing it to the enrollee.

Herrmann teaches that an electronic application form can be digitally signed before providing the user with the form in order to authenticate the form provider (See Herrmann Col. 7 Paragraph 4).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Herrmann in the method of French in order to provide a digitally signed form to the user applying for a digital certificate. This would have been obvious because the ordinary person skilled in the art would have been

motivated to provide the applicant with a guarantee of authenticity of the electronic forms.

45. Claim 33 is rejected for the same reasons as claims 23, 35, and 37 above.

46. Claim 34 rejected under 35 U.S.C. 103(a) as being unpatentable over French, and further in view of Menezes.

French teaches a method for issuing digital certificates to users (See French Abstract), but French fails to disclose how the digital certificates are verified once they have been issued.

Menezes teaches that when a digital certificate is used, a certification authority verifies the uses of the certificate (See Menezes Page 560 Section ii).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Menezes in the method of French in order to authenticate the use of a digital certificate. This would have been obvious because the ordinary person would have been motivated to provide authentication of the certificates it issued, as is inherently necessary in the use of digital certificates.

Claim 35 recites recording the uses of the digital credential at the authentication service (See French Col. 5 Paragraph 6).

Claim 36 is rejected for the same reasons as claim 6 and 11 above as applied to claim 35.

Claim 37 recites a plurality of relying parties (See Menezes Page 559 Section 13.4.2 Paragraph 1).


Conclusion

47. Claims 1-41 have been rejected.

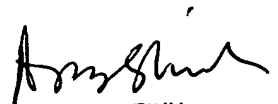
48. Any inquiry concerning this communication should be directed to Matthew Henning whose telephone number is (703) 305-0713. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Matthew Henning
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Art Unit 2131



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